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CENTRAL FAX CENTER****AUG 17 2006****Atty. Docket No. CQ10187
PATENT APPLICATION**

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/942,666

REMARKS

Claims 1-5, 7-25, 27-48, 50-66, 68 and 70-73 are all the claims pending in the application.

Examiner Interview

Applicants thank the Examiner for courtesies extended to Applicants in connection with the Examiner's telephonic interview with Applicants' representative, which took place on July 20, 2006.

Allowable Subject Matter

Applicants thank the Examiner for indicating that a prior art rejection cannot be made with respect to claims 1-5, 7-25, 27-48, 50-66 and 70-73 and that those claims are directed to allowable subject matter.

Objection Under 35 U.S.C. 132(a)

The Examiner has objected to the Amendment filed by Applicants on March 13, 2006 under 35 U.S.C. 132(a) for allegedly introducing a new matter into the disclosure. In response, Applicants amend paragraph 0037 of the specification adding the reference to the shape characteristic of the digital ink. Because the Examiner has acknowledged in the Office Action that the originally filed claim 21 recited "wherein the display attribute include ... shape of the selected digital inks," the present amendment of paragraph 0037 does not introduce the new matter into the disclosure.

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Objections to Claims 7, 27, 28 and 50

The Examiner objected to claims 7, 27, 28 and 50 for being dependent upon cancelled parent claims. In response, Applicants amend these claims to depend on claims 1, 24 and 44. This amendment is believed to be fully responsive to the Examiner's objection.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner has rejected claims 1-5, 7-25, 27-48, 50-66, 68 and 70-73 under 35 U.S.C. 112, second paragraph, as being allegedly indefinite. Applicants respectfully traverse this rejection in view of Applicants' amendments to the claims and further in view of the following arguments.

With respect to claims 1, 4, 24, 44 and 47, while Applicants continue to traverse the Examiner's characterization of the teachings of the disclosure, Applicants respectfully submit that the rejection of these claims has been overcome by virtue of Applicants' amendments to those claims, wherein Applicants deleted "at least." Therefore, the amended claims 1, 4, 24, 44 and 47 are patentable.

With respect to the Examiner's rejection of claims 21, 41 and 64, Applicants added the description of the shape characteristic to paragraph 0037 of the specification, as it has been stated hereinabove. Thus, Applicants' amendment to paragraph 0037 has fully overcome the Examiner's rejection of the aforesaid claims. Therefore, claims 21, 41 and 64 are patentable.

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Applicants further respectfully submit that the rejection of claims 7, 27, 28 and 50 has been rendered moot by virtue of Applicants' amendments to those claims, wherein the objectionable claims dependencies have been corrected. Therefore, claims 7, 27, 28 and 50 are patentable.

Finally, the Examiner stated that claims 70-73 omit essential elements. Applicants respectfully disagree. A claim may be rejected as omitting essential element only if it omits matter disclosed to be essential to the invention as described in the specification or in other statements of record. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c)(c). Here, the specification does not describe any of the steps alleged by the Examiner as essential steps. Thus, claims 70-73 do not omit essential elements and, therefore, they are not indefinite. If the Examiner continues to insist that claims 70-73 omit any essential steps, Applicants respectfully request the Examiner to point to specific language in the specification designating the allegedly omitted steps as essential or necessary. Thus, claims 70-73 are patentable.

Thus, for all the foregoing reasons, claims 1-5, 7-25, 27-48, 50-66, 68 and 70-73 are patentable.

Rejections under 35 U.S.C. 112, first paragraph

The Examiner rejected claims 1-5, 7-25, 27-48, 50-66 and 70-73 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with written description requirement. Applicants

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respectfully traverse this rejection in view of Applicants' amendments to the claims and further in view of the following arguments.

With respect to claims 1, 4, 24, 44 and 47, while Applicants continue to traverse the Examiner's characterization of the teachings of the disclosure, Applicants respectfully submit that the rejection of these claims has been overcome by virtue of Applicants' amendments to those claims, wherein Applicants deleted "at least." Therefore, the amended claims 1, 4, 24, 44 and 47 are patentable.

While Applicants continue to traverse the Examiner's characterization of the teachings of the disclosure, Applicants amend claims 70-72 to remove the word "only." This amendment is believed to overcome the Examiner's rejection of claims 70-73.

Thus, for all the foregoing reasons, claims 1-5, 7-25, 27-48, 50-66, 68 and 70-73 are patentable.

Rejections under 35 U.S.C. 101

The Examiner rejected claims 1-5, 7-25, 27-48, 50-66 and 70-73 under 35 U.S.C. 101 as being allegedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection in view of amendments to independent claims 1, 24, 44, 68 and 70-72 and further in view of the following arguments.

Specifically, Applicants amend the rejected independent claims 1, 24, 44, 68 and 70-72 to recite temporary digital ink for display on a media. Applicants respectfully submit that the

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claimed temporary digital ink displayed on a media creates an improved image that that can be readily observed by a person, and, therefore, the amended claims recite a useful, concrete and tangible result. In other words, the claimed invention as a whole accomplishes a practical application, including an improved image created when the temporary digital ink is displayed on a media. For this reason, claims 1, 24, 44, 68 and 70-72 do not recite an abstract idea, and, therefore, they are directed to statutory subject matter and are allowable under 35 U.S.C. 101. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

Thus, for all the foregoing reasons, claims 1-5, 7-25, 27-48, 50-66 and 70-73, which include both the amended independent claims 1, 24, 44, 68 and 70-72 and their respective dependent claims, are directed to statutory subject matter and, therefore, are patentable.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

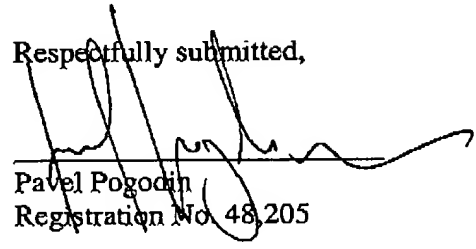
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Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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Date: August 17, 2006

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the U.S. Patent and Trademark Office this 17th day of August, 2006.


Monica Moreno